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EXAMINER

ALTER, ALYSSA MARGO

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARMAINE K. HARRIS and JOSEPH J. KLEIN

Appeal 2009-005351
Application 10/773,121
Technology Center 3700

Before: WILLIAM F. PATE III, STEFAN STAICOVICI, and
KEN B. BARRETT, Administrative Patent Judges.

PATE III, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a response to a Request for Rehearing in Appeal 2009-005351. Requests for Rehearing are limited to matters overlooked or misapprehended by the Panel in rendering the original decision. 37 C.F.R. § 41.52.

Appellants argue that the Panel misapprehended or overlooked that there is no apparent reason for one of ordinary skill to have found the subject matter of claims 38-40, 42, and 43 to have been obvious. Req. Reh'g 2. Independent claim 38 is directed to the feature of a dilator for widening the path through an epidural region proximate to the spine of a patient. The dilator lumen is claimed as having a substantially oblong cross-section.

The Examiner argued that it would have been obvious to have modified the dilator, dilator sheath, and needle of Mamo with the oblong or oval cross section as taught by DeWindt in order to provide the predictable result of utilizing the available space more efficiently than the traditional round cannula of Mamo. Ans. 4. The Examiner cited DeWindt, column 1, lines 9-11 for support of this reasoning. Ans. 6.

We stated in our Decision of August 11, 2010, that one of ordinary skill would recognize that minimizing invasiveness to the patient by using the cross-sectional shape disclosed by DeWindt would have been a predictable and advantageous feature of a variety of surgical instruments. Decision 4. Thus, we found Appellants' argument unpersuasive. Appellants, on reconsideration, argue that this is a new argument that contrasts with the Examiner's argument regarding maximizing available space more efficiently. Req. Reh'g 2.

We disagree that this is a new rationale for supporting the rejection. In our view, maximizing available space for the small cross-sectional area of the cannula and minimizing trauma are two sides of the same coin. DeWindt

teaches the efficiency of the opening is maximized by providing an oblong cross-section. DeWindt, col. 1, ll. 9-11. By using such a cross section the overall area of the opening can be decreased thereby limiting the trauma inflicted upon the patient. Over against the reason given in the DeWindt patent for the oblong cross section, Appellants merely argue that modifying Mamo to include this shape “would likely increase the invasiveness” of the procedure. Req. Reh’g 3. This unsupported argument is not credited.

Appellants also include an argument based on the shape of the stimulation lead disclosed in Mamo. Req. Reh’g 3. This argument is irrelevant to independent claim 38 which is directed to the subject matter of a dilator per se. Decision 5.

For the forgoing reasons, Appellants have failed to convince us that any matter has been misapprehended or overlooked in the rendering of our original Decision. Reconsideration has been Granted to the extent that we have reconsidered our previous decision. It is Denied with respect to making any changes thereto.

DECISION

Upon reconsideration, the rejection of claims 38-40, 42 and, 43 under 35 U.S.C. § 103 remain affirmed.

RECONSIDERATION DENIED

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